

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of: Guy J. Rackham

Group Art Unit: 3623 : IBM Corporation
Examiner: Nadja N Chong Cruz : Intellectual Property Law
Serial No.: 10/796,367 : Department SHCB/040-3
Filed: 03/09/2004 : 1701 North Street
Confirmation No. 2245 : Endicott, NY 13760
Title: SERVICES COMPONENT :
BUSINESS OPERATION
METHOD

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Appellant hereby appeals from the Final Action of 12/13/2008 and offers the following arguments in support thereof.

(i) REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, a corporation of New York, with a place of business at Armonk, NY 10504.

(ii) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences with which the undersigned is aware.

(iii) STATUS OF CLAIMS

Claim 22 is pending in the present application. Claim 22 has been finally rejected and is the subject matter of this appeal.

(iv) STATUS OF AMENDMENTS

There were no amendments filed subsequent to the final rejection dated 12/31/2008.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Appellant's invention relates to a unique computer program product for instructing a processor to operate a business.

Appellant's sole independent claim 22 is drafted in the well known Beauregard form as a series of program instruction means for performing actions for operating a business. The program instruction means are all recorded on a computer readable medium. Because the Beauregard form is conventional and well known to one of ordinary skill in the art, the structure corresponding to the means for each claimed function need not be disclosed in detail. (MPEP 2163, II, A, 3 (a)). The program product builds a map of components of activities. (FIG. 1, step 12, and Specification page 5, line 21 - page 6, line 3). An example of such a map is shown in FIG. 2 and is described on page 6, line 4 - page 7, line 25. The program product filters
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the map to form a two dimensional heat map of related components. (FIG. 1, step 14, and page 7, line 27 - page 9, line 15). The program product defines attributes for the selected components 16 based on a competency lens 18. The competency lens has to include four competency offerings of business strategy, information technology strategy, organizational strategy, and operations strategy. (Page 9, line 16 - page 10, line 10). The program product identifies collaborations 20 including patterns to be applied to the selected components to model how the selected components collaborate. (Page 10, line 11 - page 18, line 9, and FIGs. 4 - 5).

The program product builds a three dimensional business component solution stack 22 using the heat map 14, the attributes 16, and the collaborations 20. (Page 18, line 17 - page 19, line 9). The program product develops quick hits and investment opportunities 24 from the solution stack 22. (Page 19, lines 10 - 26). The program product defines a roadmap of tasks 26 for implementing the quick hits and investment opportunities 24. (Page 19, line 27 - page 20, line 3). The program product implements the roadmap 28 for the business. (Page 20, line 4 - 9).

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There is only one ground of rejection. Claim 22 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Northcott (US 2003/0167198A1) in view of American Cybernetic Corporation - 2001 and further in view of the Lindsay-Scott (US 2004/0117234A1).

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(vii) ARGUMENT

Claim 22 is patentable under 35 U.S.C. 103(a) over the prior art.

The combination of Northcott with American Cybernetic and Lindsay-Scott does not describe all of the limitations of Appellant's claim 2. Appellant therefore respectfully disagrees with this rejection and offers the following arguments to support this.

In claim 22, Appellant claims a map of components. Northcott describes in the cited paragraph [0008] a map of tasks. These are not the same maps. Appellant defines component on page 5 of his Specification to be taken to mean a group of cohesive business activities supported by appropriate processes, applications, infrastructure, and metrics. Even if one were to argue that Northcott's tasks in [0008] correspond to Appellant's activities, each of Appellant's components is clearly defined as a group of activities. Appellant's component map is therefore a map of groups of activities (tasks) and not a map of activities themselves as described by Northcott. The examiner errs in stating that Northcott [0008] describes Appellant's component map.

Appellant claims filtering his map of components to form a two dimensional heat map of selected components. A heat map is defined in Appellant's Specification page 9, lines 14 - 15, as a component map having only the selected components. Northcott does not describe this filtering step. Northcott describes
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selecting a potential target task and mapping this potential target task into a network of one or more sub-tasks. The sub-tasks are obviously not tasks from his original map of tasks. In fact, Northcott describes selecting only a single target task. He does not describe selecting a plurality of target tasks and therefore does not map a plurality of target tasks into a heat map of selected components as required by Appellant's claim 22.

The Examiner states that selecting a plurality of target tasks is not recited in claim 22. Appellant disagrees. Claim 22 clearly requires the heat map of selected components to be two dimensional. A two dimensional map of objects, components, or anything must clearly have at least three elements. If less than three, then the map is obviously one dimensional. Appellant's two dimensional map requires at least three elements. Therefore, Northcott does not describe filtering said map of components to form a two dimensional heat map of selected components as required by claim 22. The Examiner has erred in stating that a plurality of components is not required by claim 22.

Claim 22 further requires defining attributes for the selected components, based on a competency lens. The competency lens must include competency offerings of business strategy, information technology strategy, organizational strategy, and operations strategy. The Examiner admits in his final rejection of 12/31/2008, page 5, center paragraph, line 4, that Northcott does not teach a competency lens including competency offerings to these four strategies. However, the Examiner states that
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American Cybernetic teaches this on pages 1 - 2, 7th paragraph. Appellant respectfully disagrees. Although American Cybernetic uses similar wording for three of Appellant's four strategies, claim 22 requires competency offerings of four strategies. American Cybernetics lists five types of analysis, but there is no description or suggestion even when combined with Northcott, that these analyses involve competency offerings. Furthermore, American Cybernetics does not describe business strategy, as required by claim 22 and confusingly uses organizational strategy twice. The Examiner has erred in stating that Northcott in combination with American Cybernetics describes or suggests a competency line including competency offerings of business strategy, information technology strategy, organizational strategy, and operations strategy.

Finally, claim 22 requires identifying collaborations, including patterns to be applied to the selected components to model how the selected components collaborate. The Examiner has correctly stated that Northcott does not describe this. However, the Examiner states that Lindsay-Scott in the figure of page 38 teaches this. Appellant respectfully disagrees with the Examiner's statement in paragraph 13 of the final rejection of 12/31/2008 that "performing a knowledge management assessment of cultural behaviors and draws on behavioral science" teaches the claim 22 requirement of including patterns to be applied to the selected components. Appellant also respectfully disagrees that "for establishing better work practices" teaches the claim 22 requirement of modeling how the selected components collaborate.

For all of the reasons above, Appellant's claim 22 is
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allowable over the combination of Northcott with American Cybernetic and Lindsay-Scott. Appellant's position is that rejection of pending claim 22 is in error and must be withdrawn.

In view of the above, Appellant respectfully requests the Board to reverse the Examiner's final rejection of claim 22 on Appeal, and allow this claim.

Respectfully submitted,

Dated: 04/27/2009

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(viii) CLAIMS APPENDIX

22. A computer program product for instructing a processor to operate a business, said computer program product comprising:

a computer readable medium;

first program instruction means for building a map of components of activities;

second program instruction means for filtering said map of components to form a two dimensional heat map of selected components;

third program instruction means for defining attributes for said selected components, based on a competency lens, said competency lens including competency offerings of business strategy, information technology strategy, organizational strategy, and operations strategy;

fourth program instruction means for identifying collaborations including patterns to be applied to said selected components to model how said selected components collaborate;

fifth program instruction means for building a three dimensional business component solution stack using said heat map, said attributes, and said collaborations;

sixth program instruction means for developing quick hits and investment opportunities from said solution stack;

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seventh program instruction means for defining a roadmap of tasks for implementing said quick hits and investment opportunities; and

eighth program instruction means for implementing said roadmap for said business; and wherein

all said program instruction means are recorded on said medium.

(ix) EVIDENCE APPENDIX

None.

(x) RELATED PROCEEDINGS APPENDIX

None.